

Claims 17-34 are pending in the present application. Claims 19 and 22-33 have been withdrawn from consideration. The Specification has been objected to. Claims 17, 18 and 34 were rejected under 35 U.S.C. § 102(b) based on U.S. Patent Application Publication No. 2002/0104961 to Hoffman ("Hoffman"). Claims 20-22 were rejected under 35 U.S.C. § 103(a) based on Hoffman in view of U.S. Patent No. 5,140,458 to Takagi et al. ("Takagi").

Information disclosure statement

Status of the Specification

The Abstract was objected to for allegedly including the word “comprising.” However, it is respectfully submitted that the amended Abstract, filed with the Preliminary Amendment dated March 1, 2006, does not include the word “comprising.” Similarly, the disclosure was objected to for missing section headings. However, the amendments to the Specification made in the Preliminary Amendment dated March 1, 2006 added section headings. Accordingly, it is unclear if the objection was erroneous, or if the amended Abstract and amendments to the Specification have not been entered. It is respectfully requested that the objection be clarified. Further, if any action is required on the part of the Applicant to have the amended Abstract or amendments to the Specification entered, it is respectfully requested that such action be specified by the Examiner.

Rejections Under 35 U.S.C. § 102

Claims 17, 18 and 34 were rejected under 35 U.S.C. § 102(b) based on U.S. Patent Application Publication No. 2002/0104961 to Hoffman ("Hoffman").

Hoffman describes a scanning microscope with a light source that provides laser light from a laser 7 to a specimen 25 through several optical systems 19, 21, 29 and 33. The first optical system 29 is disposed upstream of a retardation plate 31. The second optical system 33 is used for focusing. Optical systems 19 and 21 are disposed between a gimbal-mounted scanning mirror 17 and the specimen 25. See Hoffman, paragraphs [0034] to [0035] and Fig. 1.

Independent claim 17 of the present application has now been amended so as to recite "an optical system configured to image the optical component into a pupil of the objective and to adjust a size of an image of the optical component while maintaining the image of the optical component in the pupil of the objective." Support for this amendment may be found, for example, in paragraph [0019] of the Specification.

It is respectfully submitted that Hoffman does not teach the above-recited feature of independent claim 17. In contrast, Hoffman describes a scanning microscope with a several optical systems 19, 21, 29 and 33, but does not teach that any of the optical systems are "configured to adjust a size of an image of the optical component" as recited in independent claim 17. First, optical system 29 is not positioned between the retardation plate 31 and the optical system 23, and thus cannot influence the image size of the retardation plate 31. See Hoffman, Fig. 1. Second, Hoffman describes optical system 33 merely for the use of focusing light. See Hoffman, paragraph [0035]. Further, Hoffman does not describe the structure or function of optical systems 19 and 21, and specifically does not teach that they are configured for adjusting the size of an image of the retardation plate 31. Moreover, optical systems 19 and 21 are disposed between the gimbal-mounted scanning mirror 17 and the optical system 23 and a person of ordinary skill in the art would understand that these optical systems would not be configured for adjusting the size of the image of retardation plate 31. Accordingly, Hoffman does not teach any optical systems configured to adjust a size of an image of an optical component, as recited in claim 17. Furthermore, Hoffman does not teach that the optical systems are configured to adjust image size "while maintaining the image of the optical component in the pupil of the objective" as recited in amended claim 17.

Because Hoffman fails to teach this feature of claim 17, it cannot anticipate claim 17 or its dependent claims 18-34.

Reconsideration and withdrawal of the rejection of claims 17, 18 and 34 under 35 U.S.C. § 102(b) based on Hoffman is respectfully requested.

Rejections Under 35 U.S.C. § 103

Claims 20-22 were rejected under 35 U.S.C. § 103(a) based on Hoffman in view of U.S. Patent No. 5,140,458 to Takagi et al. ("Takagi").

Takagi describes an optical illuminating apparatus using drive systems with motors for and gears for changing the magnification of the apparatus. See Takagi, abstract, column 3, and Fig. 1.

Claims 20-22 depend from independent claim 17. It is respectfully submitted that Takagi does not cure the deficiencies of Hoffman with respect to rendering claim 17 unpatentable. There would be no reason, in view of Takagi, for a person of ordinary skill in the art to add the above-recited features of claim 17 that are missing from Hoffman to the scanning microscope of Hoffman. Takagi merely describes an illuminating apparatus that uses drive systems for changing magnification. See Takagi, abstract. Thus, any combination of Hoffman and Takagi, to the extent proper, could not render dependent claims 20-22 obvious.

Reconsideration and withdrawal of the rejection of claims 20-22 under 35 U.S.C. § 103(a) based on Hoffman in view of Takagi is respectfully requested.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Respectfully submitted,

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